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(For *Inter Partes* Reexamination Requester)

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REEXAM UNIT

In re Campana, Jr. et al
Inter Partes Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No.: 6,317,592

DECISION DENYING PETITION

This is a decision on the October 7, 2005 patent owner [1] petition filed under 37 CFR §§ 1.181 and 1.907 and 35 U.S.C. § 317 in this merged proceeding. The present petition requests reconsideration of the Office's September 16, 2005 decision dismissing patent owner's July 7, 2005 original petition; in that original petition, the patent owner requested that the 90/006,495 and 95/000,020 reexamination proceedings be severed, [2] and that *inter partes* proceeding 95/000,020 be dismissed and terminated pursuant to 37 CFR 1.907. In addition to requesting reconsideration of the September 16, 2005 decision, the present petition requests that the Office declare its decision to constitute a final agency action within the meaning of 5 U.S.C. § 704.

[1] United States Patent No. 6,317,592 is owned by NTP, Inc. All references, *infra*, to NTP, Inc are to be understood as referring to the "patent owner."

[2] The July 7, 2005 original "Petition to Sever and Dismiss ... *Inter Partes* Reexamination ..." did not request that the requested relief be in any way limited to any particular claims, or to any particular number of claims. The request for reconsideration now requests that the merged proceeding be terminated with respect to at least the six claims of United States Patent No. 6,317,592 for which validity has "been fully adjudicated," and requests dismissal and termination of the severed 95/000,020 *inter partes* reexamination proceeding.

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On October 21, 2005, the third party requester [3] filed a petition in opposition to the patent owner's October 7, 2005 request for reconsideration and for designation of any decision reached as being as a final agency action.

The 90/006,495 and 95/000,020 reexamination proceedings are before the Director of the Office of Patent Legal Administration for consideration of the present patent owner and third party requester petitions.

SUMMARY

The October 7, 2005 patent owner petition is granted to the extent that (a) the September 16, 2005 decision on the July 7, 2005 patent owner petition has been fully reconsidered, and (b) the instant decision is designated as a final agency action under 5 U.S.C. § 704. However, for the reasons set forth below, patent owner's request for reconsideration is denied with respect to the underlying requested relief of severing the merged proceeding and terminating the 95/000,020 *inter partes* reexamination proceeding.

In addition, for reasons discussed below, the third party requester's October 21, 2005 opposition petition is granted to the extent that the merged reexamination proceeding will not be severed and the 95/000,020 *inter partes* reexamination proceeding will not be terminated, but is denied insofar as it opposes designating the instant decision as being a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. U.S. Patent No. 6,317,592 (hereinafter the '592 patent) issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, reexamination of the '592 patent was ordered at the initiative of the Director of the United States Patent and Trademark Office, and the resulting reexamination proceeding was assigned control number 90/006,495 (hereinafter the '495 reexamination proceeding).

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed in the Office by a third party requester, resulting in reexamination proceeding control number 95/000,020 (hereinafter the '020 reexamination proceeding).

4. On August 12, 2003, the patent owner filed a notice of concurrent proceedings under 37 CFR 1.985 in Control No. 95/000,020. The notice advised the Office of a final decision and order dated August 5, 2003, that was issued by the U.S. District Court for the Eastern District of Virginia, in *NTP, Inc. V. Research In Motion*, C.A. # 3:01CV767 (E.D. Va., August 2003). The August 12, 2003 notice provided a copy of the court order and its accompanying memoranda and other orders issued by the court. The materials were provided by the patent owner for the purpose of asserting that the District Court found the defendant, third party requester RIM, (a) not to have sustained its burden of proving the invalidity of any patent claim in the '592 patent, and (b) to have infringed

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[3] The third party requester in *inter partes* reexamination proceeding 95/000,020 is David L. Stewart. However, the real party in interest is Research in Motion, Ltd. (hereinafter "RIM"). All subsequent references to RIM are to be understood as referring to the "third party requester."

certain of plaintiff NTP's patent claims in the '592 patent. [4] Pursuant to Federal Rules of Appellate Procedure Rules 3 and 4, the District Court's decision was appealable within 30 days.

5. On August 26, 2003, the Office issued an order in the '020 reexamination proceeding granting *inter partes* reexamination of the '592 patent. The August 26th order notified the parties to the '020 reexamination proceeding that the decision in the litigation referred to in the August 12, 2003 Notice (see preceding paragraph) might provide grounds for termination of the '020 reexamination proceeding.

6. On October 10, 2003, the patent owner filed a petition under 37 CFR 1.181 (the "original" petition), requesting that the '020 reexamination proceeding be dismissed, *i.e.*, terminated. Patent owner argued that the District Court's holding and decision in *NTP, Inc. v. Research In Motion* [5] constituted a "final decision" within the meaning of 35 U.S.C. § 317(b), and accordingly, the '020 reexamination proceeding, filed by a third party requester who was argued to be in privy with defendant in the litigation, could not be maintained by the Office.

7. On June 2, 2004, the October 10, 2003 patent owner petition was dismissed on the grounds that the decision of the U.S. District Court relied upon by patent owner was not a "final decision" within the meaning of 35 U.S.C. § 317(b).

8. On August 9, 2004, the Office issued a decision, *sua sponte*, merging the '020 *inter partes* reexamination proceeding and the '495 *ex parte* reexamination proceeding into a single merged proceeding pursuant to 37 CFR 1.989(a). The decision merging the two reexamination proceedings stated that the merged proceeding would be governed by the provisions of 37 CFR 1.902 through 1.997, as required by 37 CFR 1.989(b).

9. On December 14, 2004, a decision of the Federal Circuit was rendered in the *NTP, Inc. v. Research In Motion* litigation. [6]

10. On July 7, 2005, patent owner filed a petition to sever the instant merged proceeding and to dismiss and terminate the '020 *inter partes* reexamination proceeding.

11. On July 20, 2005, requester filed a petition opposing patent owner's July 7, 2005 petition.

12. On August 2, 2005, the Federal Circuit issued an Order granted a request for panel rehearing and rehearing *en banc* for the limited purpose of revising portions of the opinion treating Section 271 of Title 35 of the United States Code, and withdrawing the December 14, 2004 opinion. [7]

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[4] A review of the final order (and accompanying orders and memoranda), as well as from the three opinions of the U.S. District Court for the Eastern District of Virginia (Richmond Div) styled as "*NTP, Inc., Plaintiff v. Research in Motion, Ltd., Defendant*" reported at 270 F. Supp. 2d 751; 67 USPQ2d 1594 (May 23, 2003); 67 USPQ2d 1587 (May 23, 2003); and 261 F. Supp. 2d 423; 67 USPQ2d 1574 (November 4, 2002), does not show that the District Court found all of the claims of the '592 to be not invalid. See also *NTP, Inc., v. Research In Motion, Ltd.*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004), from which it appears that claims 40, 150, 278, 287, 653 and 654 of the '592 patent were held to be infringed by RIM; presumably, at least these claims were held to be "not invalid" in order for them to have been held by the court to be infringed.

[5] Presumably the petition referred to the final order discussed in item 4, *supra* and/or the published opinions of the District Court Cited in the above footnote.

[6] *NTP, Inc. v. Research in Motion, Ltd*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004).

[7] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282; 75 USPQ2d 1763 (Fed. Cir. 2005)

13. On August 2, 2005, the Federal Circuit also issued a substituted opinion. [8]

14. On August 16, 2005, third party requester filed a petition for panel rehearing and rehearing *en banc*, based upon the Federal Circuit's August 2, 2005 opinion.

15. On September 16, 2005, the Office rendered a decision dismissing the patent owner's July 7, 2005 petition to sever the merged proceeding, and terminate the '020 *inter partes* reexamination proceeding.

16. On September 28, 2005, the Office issued a first Office action on the merits (*i.e.*, on the patentability of the '592 patent claims) in which all patent claims, *i.e.* claims 1-665, were rejected. The rejection was based upon prior art (*e.g.* the so-called "TeleNor" prior art) , which was not of record until well after the *ex parte* and *inter partes* reexamination proceedings had been individually ordered and subsequently merged into a single proceeding. The TeleNor prior art does not appear to have been considered during any of the court proceedings.

17. On October 7, 2005, the Federal Circuit denied the third party requester's petition for a panel hearing and rehearing *en banc*. [9]

18. Also on October 7, 2005, the patent owner filed the instant petition requesting reconsideration of the September 16, 2005 decision, and designation of the decision on the request for reconsideration as a final agency action under 5 U.S.C. § 704.

19. A motion to stay issuance of the Federal Circuit's mandate was filed by RIM on October 13, 2005.

20. On October 21, 2005, the Federal Circuit denied the motion to stay and issued its mandated, remanding the case to the District Court for further proceedings pursuant to the Federal Circuit's August 2, 2005 substituted opinion. [10]

21. On October 21, 2005, the third party requester filed a petition in opposition to the patent owner's October 7, 2005.

22. Subsequent news reports state that that RIM has petitioned Chief Justice Roberts for a stay of the Federal Circuit's mandate pending filing of a petition for certiorari, but the stay was denied. [11]

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[8] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282; 75 USPQ2d 1763 (Fed. Cir. 2005)
[9] *NTP, Inc. v. Research in Motion, Ltd.*, No 03-1615 (Fed. Cir. October 7, 2005)
[10] The substituted opinion is referenced in note 8, *supra*.
[11] *Patent Trademark & Copyright Journal*, Vol. 70 No. 1742, 10/28/05 (BNA). See also "Third Party Requester's ...Opposition to Patent Owner's request for Reconsideration ...", October 21, 2005, at page 9.

DECISION ON PATENT OWNER REQUEST FOR RECONSIDERATION

I. Relief Requested By Patent Owner:

In the instant request for reconsideration, patent owner renews its request that the merged proceeding be severed and that the '020 *inter partes* reexamination proceeding then be terminated. As footnoted above, in the instant request for reconsideration, patent owner requests the Office to sever the merged proceedings for at least six claims of the '592 patent that have been adjudicated as valid, but also requests that the '020 *inter partes* proceeding then be dismissed and terminated. This decision will treat the issue of severance with respect to all claims of the '592 patent and fewer than all claims of the '592 patent, and will also treat the issue of dismissal and termination of the '020 *inter partes* proceeding with respect to all claims of the '592 patent and fewer than all claims of the '592 patent.

II. Summary Of The Issue Presented And Its Resolution:

The issue presented by patent owner can be summarized as being whether the estoppel provisions of 35 USC § 317(b) divest the Office of jurisdiction in the '020 *inter partes* proceeding based on the Federal Circuit ruling and apparent affirmance of the decision of the District Court with respect to claim validity. For the reasons discussed, *infra*, the Office finds that the estoppel provisions of 35 USC § 317(b) do not divest the Office of jurisdiction in the '020 *inter partes* proceeding. The Office concludes that the language of 35 USC § 317(b) divests the Office of jurisdiction to engage in *inter partes* reexamination only when all appeal rights are exhausted insofar as a party to the litigation has no further right to appeal to a higher court or otherwise seek review on the merits by a higher court, and the litigation proceeding is terminated. In this instance, the litigation proceeding has not terminated.

III. Applicable Statutory Provision:

A. Section 317(b) of Title 35 provides:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. **This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.** [Emphasis added].

B. The legislative history of this section includes the following material, which identifies that its effect occurs after appeals and that its effect does not extend to issues concerning prior art that was unavailable:

> Sec. 4604. Optional *inter partes* Reexamination Procedure
> *****
> Subtitle F creates a new section 317 which sets forth certain conditions by which *inter partes* reexamination is prohibited to guard against harassment of a patent holder. In general, once an order for *inter partes* reexamination has been issued, neither a third-party requester nor the patent owner may file a subsequent request for *inter partes* reexamination until an *inter partes* reexamination certificate is issued and published, unless authorized by the Director. Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an inter partes reexamination instituted by the requester is favorable to patentability, **after any appeals,** that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised. **However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO.** [Emphasis added]. [12]

IV. Discussion Of September 16, 2005 Decision Dismissing The Underlying Original Petition (To Sever The Merger And Terminate The '020 Proceeding) Filed On July 7, 2005

In the original petition filed on July 7, 2005, patent owner based its argument for severing the '020 *inter partes* reexamination proceeding from the '694 *ex parte* reexamination proceeding and then terminating the '020 proceeding, upon certain language appearing in the Office's June 2, 2004 decision. The Office's June 2, 2004 decision had dismissed patent owner's October 10, 2003 petition requesting that the '020 *inter partes* reexamination proceeding be dismissed. Specifically, patent owner quoted the June 2, 2004 decision as stating that "the examination and prosecution will continue until requester has exhausted all its appeal avenues, or the time for such expires." [13] Patent owner alleged in the original petition that "[t[he Office previously recognized that dismissal of this *inter partes* reexamination would be required when a final decision was reached in the NTP versus RIM litigation." [14]

The relief requested in patent owner's original petition filed on July 7, 2005 was that the merged reexamination proceeding be severed, and that the '020 *inter partes* reexamination proceeding then be terminated. When that petition was filed, the basis for the relief requested by patent owner was that the December 14, 2004 Federal Circuit decision [15] on appeal from the District Court's decision [16] constituted a "final decision" within the meaning of 35 U.S.C. §317(b). [17] Patent owner reasoned that because the Federal Circuit had rendered a final holding of validity with respect to the claims of the '592 patent, 35 U.S.C. § 317(b) precluded the Office from maintaining the '020 *inter partes* reexamination proceeding. Patent owner argued that because the Office could not maintain the '020 *inter partes* reexamination proceeding, the Office was required to (a) sever the merged proceeding, thereby separating the '020 *inter partes* proceeding and the '495 *ex parte* reexamination proceeding into two distinct proceedings, and then (b) terminate the '020 *inter partes* proceeding.

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[12] 106 Cong Rec. S14720, Nov. 17, 1999.
[13] See "Petition to ... Sever and Dismiss ..." dated July 7, 2005, page 5, last sentence, quoting the Decision Dismissing Petition dated June 2, 2004, page 11, item number 2.
[14] See "Petition to ... Sever and Dismiss ..." dated July 7, 2005, page 6, last paragraph.
[15] See footnote 6, *supra*.
[16] See item 4 in the "Background," *supra*.
[17] See "Petition to Sever and Dismiss ... *Inter Partes* Reexamination ... ", July 7, 2005, at pages 5-7.

The decision of Senior Legal Advisor Schor (hereinafter, the "Office") dismissed the original July 7, 2005 petition for a number of reasons. The Office held that the Federal Circuit decision relied upon by patent owner [18] was not a "final decision" within the meaning of 35 U.S.C. 317(b). Rather, a decision is a "final decision" pursuant 35 U.SC. § 317(b) only after all appeals from that decision are exhausted. The Office decided that, as there had been no final decision on the validity of claims because all appeal rights had not been exhausted, the estoppel provisions of 35 U.S.C. § 317(b)(4) had not been triggered in the present case. [19]

It was further noted that 35 U.S.C. § 317(b) states that "[t]his subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." It appeared from the record of the merged reexamination proceeding that the merged proceeding was being conducted before the Office based upon significantly more applied prior art than had been asserted during the litigation. Patent owner failed to demonstrate that the prior art relied upon by the Office in the merged reexamination proceeding (in which a Director Ordered *ex parte* reexamination proceeding that was ordered on December 26, 2002 was merged with an *inter partes* reexamination proceeding filed on May 29, 2003) was not unavailable to the third party requester during the litigation that commenced in the District Court on November 13, 2001 and concluded in the District Court on May 23, 2003, *i.e.*, was not "newly discovered prior art unavailable to the third party requester and the ... Office at the time of the *inter partes* reexamination proceedings" Therefore, the Office also decided that even assuming, *arguendo*, that the Federal Circuit decision constituted a "final decision" within the meaning of 35 U.S.C. § 317(b), the termination of the '020 *inter partes* reexamination proceeding (and severance of the merged reexamination proceeding) was not required by 35 U.S.C. § 317(b), because, if the proceedings were severed, the '020 *inter partes* reexamination proceeding would still present to the Office a proceeding based upon prior art that was not available to the third party requester (and Office) during the litigation, and, perforce, was not relied upon in the litigation. [20]

In addition, the Office noted that patent owner failed to demonstrate that all of the '592 patent claims had ever been held to be "valid" or "not invalid" in the litigation. It was stated that, from the litigation record, it appeared that only 6 of the 665 claims of the '592 patent had been held to be infringed, and, therefore, held to be "not invalid." The Office pointed out that no other patent claim had been (even inferentially) held to be invalid. Accordingly, even if the merged proceeding were to be severed as requested, the '020 *inter partes* reexamination proceeding would continue with respect to at least 659 claims of the '592 patent. Additionally, the *ex parte* reexamination proceeding would remain, with all 665 claims of the '592 patent subject to reexamination. It was deemed to be undesirable for the two severed proceedings to continue independently of one another, rather than as a single merged proceeding, especially in view of the overlapping issues that would be present in the independent proceedings. [21]

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[18] As set forth in the Background section, *supra*, the December 14, 2004 Federal Circuit decision relied upon by patent owner as being a "final decision" had been withdrawn after the petition was filed, and a substituted decision dated August 2, 2005 had been issued by the Federal Circuit. The Office took the position that the August 2, 2005 was also not a "final" decision with the meaning of 35 U.S.C. § 317(b). See Decision Dismissing Petition, dated September 16, 2005, at pages 5-8.

[19] "Decision Dismissing Decision", September 6, 2005, pages 5-8.

[20] *Id*, at pages 8 and 9. This finding by the Office was made prior to the September 28, 2005 Office action in which the so-called "TeleNor" prior art was applied against the claims. The TeleNor prior art provides new art which clearly was not of record until well after the *ex parte* and *inter partes* reexamination proceedings had been ordered and merged, and was not considered during any of the court proceedings, and further distances the instant proceeding from the estoppel of 35 U.S.C. § 317(b).

V. Further Analysis And Findings

In support of patent owner's position, the present petition (requesting reconsideration) incorporates by reference all of the arguments made in patent owner's original petition filed on July 7, 2005.[22] However, patent owner's main argument is that there can be no dispute that the validity of the claims of the '592 patent was litigated in a civil action involving the requester, "with the resultant holding that these claims were not invalid." Patent owner further argues that this holding "was part of a final judgment by the United States District Court for the Eastern District of Virginia," an assertion first made by patent owner in a petition filed on October 10, 2003 and subsequently reasserted in patent owner's original July 7, 2005 petition that was based on the Federal Circuit's December 14, 2004 decision on RIM's appeal from the District Court. [23]

Patent owner argues that 35 U.S.C. § 317(b) does not simply say "once a final decision has been entered against a party in a civil action." Nor does Section 317(b) require entry of a "final judgment." Patent owner reads the term "final decision" as being qualified to state ***"[o]nce a final decision has been entered against a party in a civil action ... that the party has not sustained its burden of proving the invalidity of any patent claim in suit ...*** " (Emphasis added by patent owner.) Patent owner concludes that the statute does not require that a decision be "final" with respect to all issues in the case, but only requires that a final decision has been reached with respect to the pertinent validity issues. Patent owner believes that the instant facts show that a final decision on the pertinent validity issues has been reached in the '592 patent litigation. Patent owner's position is that even if litigation is ongoing with respect to issues other than claim validity, such as damages, scope of injunctive relief, etc., the litigation is nevertheless final on the question of claim validity within the meaning of 35 U.S.C. § 317(b).[24] This argument is addressed as now follows.

A. Patent Owner Has Not Established That Third Party Requester's Litigation Appeal Rights Have Been Exhausted Within The Meaning of 35 U.S.C. § 317(b)

The record of the '020 proceeding shows that the request for *inter partes* reexamination was filed on May 29, 2003 on behalf of RIM (the real party in interest). Reexamination was requested for all of the '592 patent claims. Upon determining that the cited prior art raised a substantial new question of patentability, [25] the Office ordered reexamination on August 26, 2003. Thereafter, on August 9, 2004, the Office merged the '020 *inter partes* reexamination proceeding with the previously ordered '495 *ex parte* reexamination proceeding. [26] The litigation record reveals that requester RIM is the defendant in a civil action regarding the '592 patent (*NTP, Inc. v. Research In Motion*).

Patent owner has previously petitioned to dismiss the '020 *inter partes* reexamination proceeding in light of the District Court's decision and supporting orders in the civil action, which are adverse to RIM. [27] The Office dismissed the previous petition on the grounds that a "final decision" had not yet been issued for the civil action, because the appellate process had not been exhausted (*i.e.*, RIM's appeal to the Federal Circuit was still pending). On December 14, 2004, the Federal Circuit rendered a decision in the *NTP, Inc. v. Research In Motion* litigation. The Federal Circuit affirmed the holding of the District Court that RIM had infringed claims 40, 150, 278, 287, 653 and 654 of the '592 patent. [28] As noted in paragraphs 10 and 11, *supra*, the Federal Circuit 's December 14, 2004 opinion was withdrawn and a new opinion has issued. [29]

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[21] *Id.* at page 10.
[22] "Request for Reconsideration ... " dated October 7, 2005, page 2.
[23] Although not expressly stated by patent owner, it is presumed that patent owner now intends to refer to the substituted Federal Circuit decision of August 2, 2005 as the "final decision" on validity. See the Background section, supra, specifically items 4, 6, 9 and 13.
[24] "Request for Reconsideration ..." dated October 7, 2005 at pages 2-3.
[25] 35 U.S.C. § 312; 37 CFR 1.923.
[26] See 37 CFR 1.989; see also MPEP § 2686.01.

The record also shows that the Federal Circuit's December 14, 2004 decision [30] was withdrawn in favor of a new decision by the Federal Circuit, as a result of a petition for rehearing that was granted on August 2, 2005. [31] Under the interpretation of 35 U.S.C. § 317(b) that patent owner previously advanced, patent owner would have had the Office sever the merged proceeding and terminate the *inter partes* proceeding based upon a decision by the Federal Circuit that was, *almost nine months subsequent to the decision*, withdrawn by the court and could well have resulted in the Federal Circuit taking an entirely different position vis-à-vis claim validity. **In and of itself, this should be sufficient to demonstrate that a decision of a court is not final until all parties have exhausted all rights subsequent to the court's decision.** Nevertheless, a detailed analysis of the meaning of "final decision" in 35 USC § 317(b) is presented below.

B. Patent Owner Has Still Not Shown That The Federal Circuit Decision Is A "Final Decision" Pursuant to 35 U.S.C. § 317(b)

Petitioner has not presented sufficient information from which to conclude that RIM's appeal rights are exhausted. The Federal Circuit decision of August 2, 2005 is not a "final decision" on claim validity, because the Federal Circuit vacated and remanded to the District Court for more work to be performed on an issue that may well effect claim validity. It is entirely possible for the District Court to alter its previous decision concerning the validity of the claims, which are also at issue in the present pending *inter partes* reexamination proceeding. Such a decision is not a "final decision" as required by 35 U.S.C. § 317(b), because, on remand, the District Court is required to conduct further work resulting in a different result subject to appeal. Therefore, there would not be a final exhaustion of all appeals. Even further, it is noted that while third party requester's petition for a stay of the Federal Circuit's injunction has been denied by Chief Justice Roberts, [32] third party requester has stated that it has a right to file a petition for *certiorari* to the United States Supreme Court and intends to do so. [33]

Since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as after a Federal Circuit decision with exhaustion of all appeal avenues as to the litigation. *See* MPEP §2686. The Office's interpretation is based on several factors including the plain language of the statute, the symmetry between the two estoppel provisions, the legislative history, and the policy underlying the whole statutory scheme.[34]

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[27] See notes 1-3, *supra*.
[28] *Id.* at 1343; 1236.
[29] See notes 5 and 6, *supra*.
[30] A decision argued as being "final" by patent owner in the July 7, 2005 "Petition to ... Sever and Dismiss ..."
[31] See Background section, *supra*, specifically items 12 and 13.
[32] See Background section, item 21.
[33] Third Party Requester's Petition ... in Opposition to Patent Owner's Request for Reconsideration... ", October 21, 2005 at page 9. See also Sup. Ct. R. 13., which provides a 90 day period to petition for certiorari.
[34] It should be noted that a "final decision" can occur at many stages and is interpreted with different meanings depending on the statute from which it emanates, - at the agency level, the district court level and the appellate court level. *See e.g.*, 5 U.S.C. § 704 (final agency decision required prior to judicial review); 28 U.S.C. § 1295 (a) (only

Section 317(b) of Title 35, in pertinent part, states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which the parties raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, . . .

35 U.S.C. § 317(b) (emphasis added). Thus, estoppel does not take effect until a "final decision . . . in a civil action" has been entered or alternatively, a "final decision" in an earlier *inter partes* reexamination has occurred. As explained in both of the earlier decisions on petition, the Office interprets the term "final decision" for both reexamination and civil action proceedings [35] as "after all appeals" when the obligations of both parties become fixed. *See* MPEP § 2686. The Office's interpretation is sound for a number of reasons.

It is well settled that "in determining the meaning of [a] statute, we look not only to the particular statutory language, but to the design of the statute as a whole and to its object and policy." *Crandon v. United States*, 494 U.S. 152, 158 (1990). Further, when interpreting terms in a statute, we "must find that interpretation which can most fairly be said to be imbedded in the statute, in the sense of being most harmonious with its scheme and with the general purposes that Congress manifested." *NLRB v. Lion Oil Co.*, 352 U.S. 282, 297 (1957).

Initially, it is to be noted that "final decisions" typically only bind the Office after all appeals are exhausted. In other words, the Office's interpretation of "final decision" as "after all appeals" is consistent with existing law, which holds that all other Office proceedings, whether *inter partes* or *ex parte*, do not terminate until the mandate is issued by the appellate tribunal (if an appeal is filed). For example, a patent application proceeding will not terminate within the Office until the Federal Circuit issues its mandate or the time for appeal has expired. *See* 37 CFR 1.197(b)(2). *See also In re Jones*, 542 F.2d 65 (CCPA 1976) ("that petitioners did not know that receipt of mandate [by PTO] . . . terminated [the] proceedings in case was an inadequate excuse for delay in filing continuation application before mandate issued"). Similarly, an *inter partes* interference proceeding within the Office will not terminate until the Federal Circuit mandate is issued or the time to file an appeal has expired. 37 CFR 41.205(a). Clearly, Office proceedings will not terminate if the Federal Circuit issues a remand order requiring the lower tribunal to perform further work that itself can ultimately be appealed to the Federal Circuit.

Second, the plain language of the statute reflects Congress' intent to provide estoppel effect in a reciprocal fashion between court (litigation) proceedings and *inter partes* reexamination proceedings. For example, an *inter partes* reexamination will bar a civil action validity challenge on the same claims only after any appeals. *See* 35 U.S.C. § 315 (c) (third party is barred from

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"final decisions" of district courts are ripe for appeal); Fed. R. App. P. 41 (b) (1998 advisory committee notes explain "a court of appeals judgment or order is not final until issuance of its mandate; at that time the parties obligations become fixed"). Accordingly, the term "final decision" must be read in the context of the particular statute in which it is embodied.

[35] The estoppel provisions are applied reciprocally for *inter partes* reexamination and civil proceedings.

raising invalidity in a civil action if claims previously "finally" held valid in an *inter partes* reexamination); *see also* 35 U.S.C. § 316 (mandating that an *inter partes* reexamination certificate cannot be issued until all appeals are exhausted). Similarly, a "final decision" in an *inter partes* reexamination proceeding will bar a subsequent *inter partes* reexamination on the same claims, and a "final decision . . . in a civil action" will bar a subsequent reexamination on the same claims. 35 U.S.C. § 317(b). Looking at the plain language of the statute, it is clear that the term "final decision" is symmetrically applied to both civil actions in court and *inter partes* reexamination proceedings within the Office throughout §§ 317(b) and 315(c). Further, there is no reason from the reading of the statute that the same term used twice in the same provision, *i.e.*, "final decision," should have two different meanings. Since *an inter partes* reexamination proceeding does not become a "final decision" holding claims valid until "after all appeals," a similar interpretation should be reciprocally applied to a civil action in court. Thus, just like a Board of Patent Appeals and Interferences ("Board") decision pending appeal is not a final decision and does not estop a civil action, a district court decision on appeal to the Federal Circuit does not estop an *inter partes* reexamination proceeding from continuing within the Office. Moreover, when a district court, as in this case, has been ordered on remand by the Federal Circuit to do further work that may alter its original decision, it is clear that any initial decision it previously entered is not final with respect to the issues it has been ordered to address.

Third, the legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states:

> Sec. 4604. Optional inter partes Reexamination Procedure *****
> ... if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity, or if a **final decision** in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised ...

145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added). Consistent with the plain language of the statute, the legislative history confirms that a "final decision" is "after any appeals." A simple reading of the legislative history reveals that Congress contemplated that a "final decision" of either a prior *inter partes* reexamination or a civil action has estoppel effect only "after any appeals." As earlier explained, the statutory scheme creates a reciprocal estoppel effect, and the term "final decision," is used equally in reciprocal fashion in the same statutory clause applied to both *inter partes* reexamination proceedings and civil actions. Accordingly, the legislative history confirms, rather than detracts from, the Office's interpretation of "final decision" as "after all appeals."

Finally, logic and policy support construing the term "final decision" as "after all appeals." For example, in this instance, the District Court entered a decision but has now been ordered to reconsider its decision on remand by the Federal Circuit. Termination of the *inter partes* proceeding prior to exhaustion of appeals would be premature. If the *inter partes* reexamination proceeding is prematurely terminated, there is no way to "un-terminate" or re-start the *inter partes* reexamination proceeding.[36] A completely new request for reexamination would have to be made in a redundant fashion, and the added time needed to go through this redundant process clearly runs counter to the "special dispatch" mandate of 35 U.S.C. 314(c). Clearly, such redundancy is a result that Congress did not intend in light of the fact that it provided the USPTO Director with the discretion to suspend parallel proceedings for "good cause." 35 U.S.C. § 314(c); 37 CFR § 1.987. Accordingly, a "final decision" as articulated in § 317 cannot occur until "after all appeals" in order for the statutory scheme to work in the efficient manner intended by Congress. In this case, such a "final decision" will not take place until after the District Court completes the further work it was ordered to do and any subsequent appeals from the District Court's subsequent decision are exhausted.

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[36] Indeed, it is not clear how the Office could grant the requested relief of **severing** the merged proceeding only with respect to the six claims determined to be "not invalid." It is also not clear why severing the merged proceedings on this basis would mandate terminating and dismissing the '020 inter partes reexamination proceeding in its entirety, notwithstanding that 659 claims would remain in the '592 that were not subject to any determination of validity in the litigation.

Thus, the Federal Circuit's August 2, 2005 decision has not been shown to be a "final decision" within the meaning of 35 U.S.C. § 317(b). Accordingly, termination of the '020 *inter partes* reexamination proceeding has not been shown to be required by the statute.

In addition, it appears from the Federal Circuit's replacement August 2, 2005 decision that the issue remanded to the District Court directly bears on the interpretation of a claim limitation appearing in claim 40 of the '592 patent. [37] Presumably, the District Court's construction of the limitation, on remand, could well effect issues directly bearing on the '020 *inter partes* reexamination proceeding, and the merged proceeding as a whole. Thus, patent owner has not shown that there has been a "final decision" with respect to the claim validity issue raised in the *inter partes* reexamination. Even if the only issue on remand is directed to claim interpretation with respect to infringement, petitioner has not demonstrated that a different construction of the claim would not require revisiting of the validity of the reinterpreted claim. Thus, notwithstanding patent owner's arguments that 35 U.S.C. § 317(b) defines "final decision" in the context of decisions on claim validity, it is clear that the action taken on remand in the District Court may reasonably have a potential impact on claim validity. Even crediting patent owner's position that continuing litigation on issues other than claim validity does not necessarily mean that a given court decision on claim validity is not final, petitioner has nevertheless failed to demonstrated that in this case, RIM will be unable to obtain a different outcome (from the initial District Court finding) regarding the interpretation of one or more of the claims of the '592 patent, and that a different interpretation would not necessarily require that the court revisit the issue of the validity of the involved claim or claims.

Further, there is still the matter of third party requester's right to petition for *certiorari* to the United States Supreme Court from the Federal Circuit's holding of claim validity. It appears that third party requester has the right to petition for *certiorari* on the issue of claim validity through January 5, 2006. [38] In light of this fact, it clearly cannot be concluded that the decision of the validity of *any* claims held valid in the litigation to date is a final decision.

Finally, if the merged proceeding were severed, the '495 *ex parte* reexamination proceeding would still remain intact. The estoppel provisions of 35 U.S.C. § 317(b) would not apply to that proceeding. Pursuant to the guidance provided by the Federal Circuit, the Office would be required to continue the '495 *ex parte* reexamination proceeding notwithstanding that there has been a final holding of claim validity. [39] In the event that the "final decision" of the Federal Circuit were then subsequently modified on the issue of claim validity (whether as a result of a determination on the remand to the District Court or as a result of a review of the Federal Circuit's decision on *certiorari* to the United States Supreme Court) and the litigation on the question of claim validity then continued, the Office could find itself in a position of having to conduct two separate reexamination proceedings on the same patent, with the proceedings being at two diverse and distinct stages. Many scenarios can be envisioned in which the *ex parte* proceeding might have to be delayed (contrary to the statutory mandate of "special dispatch") pending any prosecution necessary to bring a newly re-started (or re-filed) *inter partes* proceeding to the same point in prosecution as the on-going *ex parte* reexamination proceeding that has continued in the Office. [40] Construing 35 U.S.C. § 317(b) to require that the Office proceed with the *ex parte* proceeding while terminating, or even suspending, the *inter partes* proceeding does not bode well for conducting orderly proceedings within the Office, since the *inter partes* proceeding may potentially have to re-started or reconstituted as a result of a modification on the question of claim validity resulting from ongoing litigation.

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[37] 392 F. 3d 1336, 1349; 73 USPQ2d 1231, 1241, and, in particular, footnote 5 of the opinion.

[38] See note 42, *supra*.

[39] *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988)

In summary, if further court review can still be sought, [41] then the Federal Circuit decision is not a "final decision" within the meaning of 35 U.S.C. § 317(b). Patent owner has not supplied sufficient information to establish on the record that the Federal Circuit decision is a "final decision" within the meaning of 35 U.S.C. § 317(b). Therefore, termination of the '020 reexamination proceeding is not required by the statute. Accordingly, there is presently no reason to sever the '020 *inter partes* reexamination proceeding from the merged '495 *ex parte* reexamination proceeding and terminate the '020 *inter partes* proceeding, particularly given that the issues in both proceedings are integrally intertwined.

C. Patent Owner Has Not Demonstrated That The '020 *Inter Partes* Reexamination Proceeding Is Based Solely On Patents Of Printed Publications "Available" To The Requester (Or Office) During The Litigation

Even if petitioner could demonstrate that there has been a "final decision" in the litigation between NTP and RIM within the meaning of 35 USC § 317(b), the language of 35 U.S.C. § 317(b) reproduced immediately below, read in light of the legislative history of that statute, would nevertheless permit the '020 *inter partes* reexamination proceeding to be maintained.

35 U.S.C. § 317(b) states:

> "This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings."

The legislative history reproduced (and cited) above states:

> "[T]he third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO."

In the present instance, a review of the '020 *inter partes* reexamination proceeding, and of the litigation papers made of record by patent owner therein, [42] shows that the patents and printed publications of record in the '020 *inter partes* reexamination proceeding far outnumber the patents and printed publications **specifically** identified and discussed in the litigation related papers and reported decisions. Further, patent owner's June 30, 2004, Information Disclosure Statement (in the '020 *inter partes* reexamination proceeding) noted that less than all the prior art *submitted by the third party requester to establish the substantial new question of patentability* was submitted in the litigation. The art advanced by requester in the reexamination proceeding may not be barred by 35 U.S.C. § 317(b), unless patent owner can show that a given patent or printed publication:

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[40] As noted by the *Ethicon* court, "nothing ... prevents the Commissioner from conducting orderly proceedings within his office so long as he does not violate the statute." *See Id.*

[41] Or, the decision is "final" in the sense that it is ripe for appeal and the period for seeking review has not expired.

[42] See note 4, *supra*, with respect to available reports involving the District Court litigation

(a) was "raised" in the District Court litigation, or
(b) "could have" been raised in the litigation by requester.

With respect to element (a), the patent owner has not shown that all of the prior art relief upon in the merged reexamination proceeding "was raised" in the District Court litigation. As to element (b), the patent owner has not shown that RIM had a legal right, as to a given patent or printed publication relied on in the merged reexamination proceeding, to introduce that patent or publication into the litigation after it became "available" to RIM. Patent owner has neither alleged nor established that, at the inception of the litigation, RIM knew of the prior art that is of record in the merged reexamination proceeding that was not of record in the litigation. Alternatively, patent owner has not established that RIM learned of this "additional" prior art subsequent to the inception of the litigation and could have raised that art during the litigation but failed to do so. In particular, patent owner has not demonstrated that the prior art applied in the outstanding Office action dated September 28, 2005 that was not considered during the litigation was ever introduced into the litigation, or could have been raised therein by RIM. That is, patent owner has not established that any of the prior art of record in the merged prior was available to be introduced at the inception of the litigation, or that the prior art was available at any stage subsequent to the commencement of the litigation. Thus even if the there had been a "final" court decision within the meaning of 37 U.S.C. § 317(b), Congress legislated that an *inter partes* proceeding based upon prior art that was not raised during litigation of claim validity, and could not have been raised during such litigation, should continue in the Office.

As pointed out, the patent owner has not demonstrated that the merged reexamination proceeding is based entirely upon prior art that was raised, or could have been raised, in the litigation between NTP and RIM. It is further pointed out that the patent owner's request for reconsideration is silent on this issue. For example, patent owner has not stated whether a motion to have prior art that apparently was not of record in the litigation proceedings, (*e.g*, the so-called "TeleNor" prior art), considered by the District Court or the Federal Circuit was ever filed, and if so, what the outcome of such motion was. Accordingly, patent owner has not demonstrated that all of the patents and printed publications deemed to demonstrate a substantial new question of patentability in the *inter partes* reexamination were raised (or could have been raised) in the District Court litigation. Additionally, patent owner has not demonstrated that all of the prior art of record applied in the Office action dated September 28, 2005 [43] was raised in the District Court litigation or was known by and available to third party requester so that it could have been raised in the litigation. Therefore, even assuming, *arguendo*, that the litigation at this stage could be deemed to have reached a "final decision" on claim validity, patent owner has not demonstrated a critical element to warrant sever and termination of the '020 *inter partes* reexamination proceeding pursuant to 35 U.S.C. § 317(b).

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[43] For example, the so-called "TeleNor" prior art.

D. Patent Owner Has Not Shown That All of the Claims of The '592 Patent Have Been Held "Not Invalid"

In the September 16, 2005 decision on petition, it was stated that the District Court's prior art validity determination is limited to only those claims that NTP asserted RIM to have infringed. It does not appear that RIM attempted to invalidate every claim of the patents. With respect to the '592 patent, the issues of infringement and validity appear to be limited to claims 40, 150, 278, 287, 653 and 654. Given that only six out of six hundred and sixty-five claims of the '592 patent were **specifically** identified in the District Court's final order (August 5, 2003), the District Court's published opinions, [44] and Federal Circuit's published decision;[45] the patent owner has not established that the courts have reached a holding that **all** of the '592 claims are "not invalid" (*i.e.*, valid over the issues addressed in the litigation). In fact, it now appears that patent owner now wishes to sever the merged reexamination proceeding only with respect to the above mentioned six claims.

The estoppel effect provided by 35 USC § 317(b) is on a "claim by claim" basis and therefore, each claim must be independently analyzed. 35 USC 317(b) states that:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit ... then neither that party nor its privies may thereafter request an inter partes reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of **such issues** may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. [Emphasis added.]

In the petitions filed on October 10, 2003 and July 7, 2005, patent owner did not point out the basis for its position that **all** of the '592 claims have been held "not invalid."[46,47] Further, given the lack of information in the case reports that **all** of the '592 patent claims were determined to be "not invalid," as opposed to only those **specifically** identified by claim number, the Office was, and is, unable to conclude that the claims which have been held "not invalid" include "any such patent claim" other than claims 40, 150, 278, 287, 653 and 654, - the claims **specifically** identified. Therefore, it appears, that on the existing record, even if the '020 *inter partes* reexamination proceeding were to be severed from the merged proceeding, 35 U.S.C. § 317(b) would **not** require that the '020 *inter partes* reexamination be terminated. Rather, the '020 *inter partes* reexamination proceeding would continue with respect to the patent claims not addressed by the litigation, and the intertwined issues of the two formerly merged reexamination proceedings would continue on independently. This is considered by the Office to be a far from desirable result. Absent any basis for termination of the '020 *inter partes* reexamination proceeding, it is desirable that the two proceedings continue as a merged proceeding.

In light of patent owner's present request for relief in the form of severing "with respect to at least the six claims of United States Patent No. 6,217,592, the validity of which have been fully adjudicated," [48] it is even more clear that 35 U.S.C. § 317(b) does not require the '020 *inter partes* reexamination proceeding to be terminated. If the merged proceedings were to be severed, there would be no basis upon which to terminate the '020 *inter partes* reexamination proceeding inasmuch as the question of patentability of the remaining 659 claims would remain. Independently conducting two separate reexamination proceedings on the '592 patent with respect to 659 identical claims in each proceeding is not considered by the Office to be a desirable result. Absent any basis for completely terminating the '020 *inter partes* reexamination proceeding, it is desirable that the two proceedings continue on as a merged proceeding.

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[44] See note 1, *supra*

[45] See note 7, *supra*

[46] See note 14, *supra*

[47] It was presumed that only claims that are "not invalid", i.e. valid, can be infringed, and so it is clear that claims 40, 150, 278, 287, 653 and 654 of the '592 patent, the only claims that have specifically been held to be infringed, have also been held to be "not invalid."

DECISION ON REQUESTER'S PETITION IN OPPOSITION TO PATENT OWNER'S REQUEST FOR RECONSIDERATION

Relief Requested By Third Party Requester:

Essentially, the third party requester opposition requests that the Office not grant the patent owner's renewal of its request that the merged proceeding be severed and that the '020 *inter partes* reexamination proceeding then be terminated. That relief, requested and argued for by the third party requester, is grantable for the reasons set forth above in denying the patent owner's petition. Accordingly, that aspect of relief will not be further discussed in this portion of the decision. The third party requester additionally urges that the September 16, 2005 decision on petition is not a final agency action because "[A]n agency decision regarding a petition to sever and dismiss an *inter partes* reexamination proceeding does not rise to the level of a final agency action." [49] In support of this position, third party quotes 5 U.S.C. § 704 as follows, and relies upon the emphasized language:

> "Agency action made reviewable by statute and final agency action for which there is no other adequate remedy in a court are subject to judicial review. **A preliminary, procedural, or intermediate agency action or ruling not directly reviewable is subject to review on the review of the final agency action.** Except as otherwise expressly required by statute, agency action otherwise final is final for the purposes of this section whether or not there has been presented or determined an application for a declaratory order, for any form of reconsideration, or, **unless the agency otherwise requires by rule and provides that the action meanwhile is inoperative, for an appeal to superior agency authority.**" (Emphasis supplied by third party requester.)

I. Summary of the Issue Presented and its Resolution:

The sole issue here is whether, in a merged reexamination proceeding in which an *inter partes* reexamination proceeding has been merged with an *ex parte* reexamination proceeding, the refusal to grant a patent owner petition to sever the merged proceeding and to then terminate the *inter partes* reexamination proceeding may properly be designated as a final agency action for purposes of permitting patent owner to seek judicial review. For the reasons discussed, *infra*, the Office concludes that the language of 5 U.S.C. § 704 read in light of the statutes and regulations governing appeals in reexamination proceedings permits the Office to designate a the refusal to grant patent owner the relief petitioned for as a final agency decision.

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[48] See note 2, *supra*.

[49] Third Party Requester's Petition ... in Opposition to Patent Owner's Request for Reconsideration... ", October 21, 2005 at page 14.

II. Applicable Statutory and Regulatory Provisions:

35 U.S.C. § 315 states:

"(a) PATENT OWNER.— The patent owner involved in an *inter partes* reexamination proceeding under this chapter—

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b).

(b) THIRD-PARTY REQUESTER.— A third-party requester—

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

(c) CIVIL ACTION.— A third-party requester whose request for an *inter partes* reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the *inter partes* reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.

35 U.S.C. § 134 states in pertinent part:

(b) PATENT OWNER.— A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(c) THIRD-PARTY.— A third-party requester in an *inter partes* proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

35 U.S.C. 141 states in pertinent part:

"An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner, or a third-party requester in an *inter partes* reexamination proceeding, who is in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. ..."

37 CFR 1.181(a) states:

Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

III. Analysis and Findings:

Third party requester does not sufficiently explain why the emphasized portions of the statute (5 U.S.C. § 704), or the entire statute, would preclude designating the instant decision [50] a final agency action pursuant to 5 U.S.C. § 704, particularly since requester appears to acknowledge that the right to appeal in an *inter partes* reexamination is limited to appeal of "any decision adverse to the patentability of any original or proposed amended or new claim of the patent" under 35 U.S.C. § 315. It appears that third party requester believes that the relief sought by patent owner is appealable pursuant 35 U.S.C. § 315. However, third party requester does not expressly articulate any rationale explaining why a decision refusing to sever and terminate this *inter partes* reexamination proceeding would constitute "a decision adverse to patentability of any original or proposed amended or new claim of the patent." It may be that third party requester equates severing the merged proceeding and then terminating the '020 *inter partes* reexamination proceeding as a confirmation of the claims of the '592 patent, and that granting the relief requested by patent owner would divest third party requester of the right to appeal from a finding of validity for one or more of the '592 patent claims. This is, however, not the case.

It is clear from a consideration of 35 U.S.C. §§ 134, 141 and 315 that third party requester in an *inter partes* reexamination proceeding has a right to appeal to the Court of Appeals for the Federal Circuit, and that such appeal is only from a final decision of the Patent and Trademark Office Board of Patent Appeals and Interferences ("BPAI") as to a final decision of the primary examiner **favorable to the patentability** of any original or proposed amended or new claim of a patent. In this instance, however, there cannot be a final decision by the primary examiner as to the patentability of the claims based on the art, since the challenge is that the Office lacks jurisdiction to reexamine a patent and to consider the patentability of any original or proposed amended or new claim of the patent. In this decision, the Office is rendering a final decision that the Office does in fact have jurisdiction to reexamine the '592 patent and to consider the patentability of any original or proposed amended or new claim of that patent. This action by the Office is a final action within the meaning of 5 U.S.C. § 704, and the patent owner has a right to challenge this action by appeal to the courts, since this action is independent of the patentability issue as to the art advanced in the reexamination proceeding.

The action being taken by the Office is to deny a petition to sever the merged proceeding and to also deny patent owner's petition to then terminate the '020 *inter partes* reexamination proceeding. It is not appealable to the BPAI, because it does not involve any final adverse determination by the primary examiner on the question of patentability of any of the pending claim. Rather, pursuant to 37 CFR 1.181(a), the refusal to grant the relief requested by patent owner is petitionable, and the patent owner has done so. Since there is no appeal to the BPAI available to patent owner from the action being taken by the Office, the patent owner has the right to challenge the office holding as to its petition by way of the courts. This decision states that none of the relief requested by patent owner will be granted. Accordingly, it appears that the final refusal by the Office to grant the relief requested in patent owner's petitions filed on October 10, 2003 and July 5, 2005 clearly constitutes a final agency action for which there would be a remedy pursuant to 5 U.S.C. § 704 in an appropriate court.

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[50] As indicated in the fourth paragraph of page 2, *supra*, patent owner's "Request for Reconsideration … " is construed to request that the instant decision reconsidering the "Decision Dismissing Petition" dated September 16, 2005 be designated as a final agency action, and not that the "Decision Dismissing Petition" dated September 16, 2005 be so designated.

CONCLUSION

1. Patent owner's request to reconsider the September 16, 2005 decision is granted to the extent that the decision has been fully reconsidered, but the request to sever the '020 *inter partes* reexamination proceedings from its merger with the '495 *ex parte* reexamination proceeding and to then terminate the '020 *inter partes* reexamination proceedings is denied.

2. Patent owner has not demonstrated that the August 2, 2005 decision on appeal by the Federal Circuit is a "final decision" within the meaning of 35 U.S.C. § 317(b) that would satisfy the 35 U.S.C. § 317(b) "final decision" requirement for termination of *inter partes* reexamination proceeding '020.

3. Patent owner has not demonstrated that all of the prior art relied upon in the merged reexamination proceeding was before the District Court during the litigation of the '592 patent, or was available to the third party requester for entry into the litigation prior to the filing of the request for *inter partes* reexamination. Thus, another of the 35 U.S.C. § 317(b) requirements for termination of the *inter partes* reexamination proceeding '020 has not been demonstrated.

4. Patent owner has not demonstrated that any claims of the '592 patent other than claims 40, 150, 278, 287, 653 and 654 have been held by the courts to be "not invalid." Thus, still another of the 35 U.S.C. § 317(b) requirements for termination of *inter partes* reexamination proceeding '020 has not been demonstrated.

5. The merger of the '695 *ex parte* reexamination proceeding with '020 *inter partes* reexamination proceeding, will continue, *i.e.*, will not be severed, as petitioner has not demonstrated that there is a statutory basis to terminate the '020 *inter partes* reexamination proceeding.

6. Third party requester's petition in opposing patent owner's petition for reconsideration is granted to the extent that the severance and termination relief requested by patent owner will not be granted as set forth above, but is denied with respect to the requested relief of refusing to designate this decision as a final agency action.

7. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

8. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, or, in his absence, to Stephen Marcus, Legal Advisor, at 571-272-7710.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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